Skirting the Issue: How International Law Fails to Protect Traditional Cultural Marks from IP Theft

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Skirting the Issue: How International Law Fails to Protect Traditional Cultural Marks from IP Theft

Sonali Maulik*

Abstract

Countries have different levels of intellectual property (IP) protections. While developed countries tend to prefer more stringent IP laws, developing countries prefer weaker ones. With the enactment of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which established minimum standards of intellectual property rights (IPRs) for states party, the level of IPRs became much higher globally. However, despite affording strong protection to many types of IP, this Comment argues that TRIPS fails to provide adequate protection for traditional cultural marks (TCMs), particularly those used in developing countries. As a result, companies in developed countries have been able to steal TCMs from developing countries without violating TRIPS or other international law.

This Comment uses as an example the attempted registration by a UK company of the word kikoi, the term for a traditional East African skirt, to demonstrate that TRIPS fails to protect this type of IP. With a focus on trademarks and geographical indications, this Comment analyzes TRIPS and other laws in the context of traditional marks and argues that current international law is inadequate for the protection of traditional marks. It then discusses proposals to protect traditional IP and introduces a simple solution to the IP theft of traditional cultural marks.

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I. INTRODUCTION

In 2006, the Kikoy UK Company applied for a trademark for the term kikoy (also spelled kikoi), a Swahili word for a skirt commonly worn by men in East Africa. The move was notorious in Kenya, whose economy relies on the production and export of small-scale consumer goods, and for whom the kikoi is a traditional cultural item. The UK company withdrew its application for the trademark due to opposition from a free trade organization, but it remains unclear whether the UK Intellectual Property Office would have granted the trademark.

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5 Kenya’s Kikoys Saved (cited in note 2).

6 The UK Trade Marks Act says that marks cannot be registered if they “consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.” Trade Marks Act (1994), c 26, § 3.1(d) (UK). Since kikoi is a customary word only in East Africa, not in the “current language” of the UK, English, it would appear to fall outside this exception. Thus, it is possible that the company could have registered
The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)\(^7\) provides minimum standards for all states party. Requiring much stronger intellectual property (IP) protection than previous agreements, TRIPS has been a source of controversy since its enactment.\(^8\) The agreement resulted from negotiations during the Uruguay Round of the General Agreement of Tariffs and Trade (GATT), after negotiations in the World Intellectual Property Organization (WIPO) failed.\(^9\) Building on the Paris Convention for the Protection of Industrial Property (Paris Convention)\(^10\) and Berne Convention for the Protection of Literary and Artistic Works (Berne Convention),\(^11\) TRIPS added provisions for service marks and geographical indications, and increased the level of protection for other intellectual property rights (IPRs).\(^12\) Many have argued that TRIPS unfairly disadvantages developing countries due to its high level of IP protections because of the resources necessary for its implementation and the fact that higher protections are given to IPRs dominated by developed countries.\(^13\) Dubbed the North–South split, most of the producers of IP are located in wealthy countries where robust systems of IP protection existed long

the term as a trademark. On the other hand, the UK Act excludes marks that are “of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).” Id at § 3.3(b). The question would then turn on whether consumers of the *kikoi* would be deceived into thinking the East African item was indeed produced in East Africa. Fortunately for East African producers of the *kikoi*, the company withdrew its application. However, this example demonstrates the difficulties in determining whether traditional cultural items deserve IP protection under the current laws.

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\(^12\) Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* 142–43 (Sweet & Maxwell 3d ed 2008).

\(^13\) See Yi-chong, *Last Chance* at 46, 67 (cited in note 8). See also Kembrew McLeod, *Owning Culture: Authorship, Ownership, and Intellectual Property Law* 172 (Lang 2001) (describing international IP laws as “an unrelenting battle against developing countries to force them to adopt an intellectual property system that is advantageous to these already wealthy countries”); Brewster, 12 Chi J Intl L at 4 (cited in note 9) (noting that while TRIPS actually provides certain benefits to developing countries, it may be bad overall for them).
before TRIPS. In developing countries, however, where IP is consumed more than produced, systems of IP protection are less well-developed and TRIPS has created a huge burden both because it requires enormous administrative costs and because the benefits to these developing countries are relatively small compared with those to developed countries. As a result, many developing countries have struggled to implement TRIPS.

This Comment focuses on a different kind of North–South split, where wealthy countries misappropriate poor countries’ IP without breaking international law because of TRIPS’s focus on Western-style IPRs. As a result, wealthy countries have been able to have their cake and eat it too—they require stringent IPRs for the type of intellectual property common in those countries, yet give little to no protection to traditional knowledge, which is more common and lucrative in developing countries. This “theft” by developed countries of traditional cultural knowledge siphons money away from these emerging economies every year.

Section II introduces rationales for protecting traditional cultural marks (TCMs). Using justifications for trademarks, this Section discusses economic and humanitarian reasons for protecting marks from misappropriation. Section III analyzes the current international and domestic laws that address marks. Section IV presents a few of the proposed solutions to the problem of the theft of traditional IP and introduces a novel solution. Section V concludes.

II. WHY GIVE TRADITIONAL CULTURAL MARKS IP PROTECTION?

TCMs are often left unprotected by current IP law because they are the product of a collective effort of people across national borders and across generations. These marks are generally considered generic and are open to use by anyone. In countries where they are not generic, because the language of the

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14 See Brewster, 12 Chi J Intl L at 12–13 (cited in note 9) (describing how developed countries moved negotiations from the WIPO, which had few developing country members, to the WTO, which had many, in order to spread IPRs to those countries that had no interest in establishing them).

15 Carolyn Deere, The Implementation Game: The TRIPS Agreement and the Global Politics of Intellectual Property Reform in Developing Countries 1–2, 10 (Oxford 2009) (citing a 2002 World Bank report that estimated the costs for implementing TRIPS in various developing countries—$15.3 billion for the Republic of Korea, $5.1 billion for China, $903 million for India, and $530 million for Brazil).

16 See Section III.

17 See Madhavi Sunder, The Invention of Traditional Knowledge, 70 L & Contemp Prob 97, 112 (2007) (citing a UN estimate of $5 billion in royalties that are lost every year from the unauthorized use of traditional knowledge).

mark is not commonly spoken, they are considered “free for the taking” as trademarks. However, there are many reasons, both economic and humanitarian, for giving IP protection to traditional cultural marks. This Section will discuss why the kikoi deserves protection from international IP law.

A. The Economic Argument

The main economic reasons for granting protection to trademarks are that trademarks reduce consumer search costs and provide an incentive for producers to maintain consistent quality. In the context of traditional cultural marks, this means kikoi gives consumers information about the product and incentivizes East African producers to create high quality goods.

Trademark protection for TCMs benefits consumers by providing them with reliable information about the source of the products and ensuring authenticity. “There is a growing consumer interest in environmentally sound or socially responsible quality products—in other words, authentic products with a solid tradition behind them.” By giving trademark protection to traditional producers, it ensures that consumers are receiving an authentic traditional cultural item. Without IPRs for these products, companies that have no relation to the cultural origins of the products could sell them to consumers using the same marks. This has the potential to mislead consumers into thinking the products are authentic or, in the alternative, would require significant search costs to discover the products’ true origins. IPRs such as trademarks and geographical indications are well suited to traditional cultural items because they can be maintained in perpetuity and they cover only the mark used to identify

inserting identifying marks to distinguish their goods from those made by others; and as a result any marks on their goods would not be sufficiently unique to qualify for protection under Nigerian trademark law”.


20 This section will mainly focus on trademarks because geographical indications are relatively new and the rationales for IP protection for the two types of IPRs are similar. Geographical indications are essentially collective trademarks that identify a product as closely associated with a particular geographic area. See Jayashree Watal, Intellectual Property Rights in the WTO and Developing Countries 244 (Kluwer 2001).


22 David R. Downes, How Intellectual Property Could Be a Tool to Protect Traditional Knowledge, 25 Colum J Envir L 253, 271 (2000). See also Sunder, 70 L & Contemp Prob at 116 (cited in note 17) (citing Fair Trade coffee and dolphin-safe tuna as examples of products for which consumers are willing to pay more in order to ensure they are “free from the worry about exploitation in the process of production”).

the good rather than the underlying product itself. In fact, facsimiles of the kikoi exist and are sold under different terms in different countries, such as "sarong," "samot," and "lungi." What separates the kikoi from these items, and what distinguishes each item from the others, is geographic origin. As stated above, many consumers do care about the origins of the products they buy, and so these terms can contain useful information for consumers. Plus, there should be few concerns of access costs for producers in developed countries. In English, for example, generic terms for kikoi exist in "wrap" and "skirt."

IPRs also encourage manufacturers to maintain consistent quality. Trademarks reward producers for building up a positive reputation, but this is dependent on the producer’s ability to maintain quality consistently. If quality in the context of traditional goods means authenticity, then allowing non-traditional producers to use the same mark as traditional producers would lead to inconsistent quality and eventually destroy the value of the mark. Professors William M. Landes and Richard A. Posner explain:

The free-riding competitor will, at little cost, capture some of the profits associated with a strong trademark because some consumers will assume (at least in the short run) that the free rider’s and the original trademark holder’s brands are identical. If the law does not prevent it, free riding will eventually destroy the information capital embodied in a trademark.

30 David R. Downes and Sarah A. Laird, Innovative Mechanisms for Sharing Benefits of Biodiversity and Related Knowledge: Case Studies on Geographical Indications and Trademarks *6, prepared for UNCTAD Biotrade Initiative (Center for International Environmental Law 1999), online at www.ciel.org/Publications/InnovativeMechanisms.pdf (visited Mar 30, 2012) (IPRs “reward producers that invest in building the reputation of a product. They are designed to reward good will and reputation created or built up by a producer or a group of producers over many years or even centuries”).
31 Landes and Posner, 30 J L & Econ at 270 (cited in note 21) (explaining that inconsistent quality undermines the effectiveness of a trademark and discourages consumers from paying more for the trademarked good than for an un-trademarked good).
32 Id.
Non-traditional producers using traditional marks free ride off the reputation built up over generations of traditional production. Allowing them to use TCMs wears away at that reputation until the mark is of little value.\(^3\)

Some have argued that traditional knowledge, such as the generic mark *kikoi*, deserves no IP protection because it is incompatible with IP.\(^3\) Generic marks are not generally given protection because they have few information benefits to consumers and unfairly restrict competition.\(^3\) However, *kikoi* and other TCMs are often generic only in their countries of origin, which is not problematic because each local producer within the country of origin is "authentic" such that the consumer information and quality control rationales are satisfied. Therefore, there is still valuable information embedded in the mark for consumers in other countries, as the marks indicate both the country of origin and the good's status as a traditional cultural item. Costs imposed on potential competitors by protecting *kikoi* are insignificant as those who want to market and sell colorful skirts can still do so with the use of other marks, such as "skirt" or "wrap." Another common argument is that, rather than being the result of the creativity and innovation of one firm or individual, these items belong to entire communities, an attribute inconsistent with most IPRs. However, the introduction of collective IPRs, such as geographical indications,\(^3\) collective marks, and certification marks, has provided a way to get around the collectivist problem inherent in many traditional cultural marks.\(^3\)

B. The Humanitarian Argument

Not entirely unrelated to the economic benefits of IPRs for traditional handicrafts are the humanitarian benefits. Millions of people around the world

\(^3\) Additionally, some have argued that inferior quality often accompanies mass production, which may also serve to damage the reputation of the mark. See Kuruk, 48 Am U L Rev at 773 (cited in note 18).

\(^3\) See, for example, Shubha Ghosh, *Globalization, Patents, and Traditional Knowledge*, 17 Colum J Asian L 73, 80 (2003) ("Public domain advocates see the creation of intellectual property rights in traditional knowledge as leading to the path of destroying traditional structures and institutions.").

\(^3\) Landes and Posner, 30 J L & Econ at 291–93 (cited in note 21) (noting that "any legal protection for generic names will create socially wasteful opportunities to earn rents").

\(^3\) See Section III.B.2.

\(^3\) Collective and certification marks grant protection to IP collectively owned by multiple people or enterprises. Collective marks distinguish some characteristic, such as geographical origin or material, of goods or services of enterprises that are members of an association. The association owns the mark and is responsible for setting standards and ensuring that those using the mark are complying with its standards. Certification marks differ in that they may be used by anyone who complies with the standards, not just members of the associations that own them. See WIPO, *Collective Marks*, online at http://www.wipo.int/sme/en/ip_business/collective_marks/collective_marks.htm (visited Mar 30, 2012); WIPO, *Certification Marks*, online at http://www.wipo.int/sme/en/ip_business/collective_marks/certification_marks.htm (visited Mar 30, 2012).
are employed as producers of handicrafts.\textsuperscript{38} For many of those people, there exist few employment alternatives. In India, for example, around nine million people are employed in the field of handicrafts creating over $3 billion in income.\textsuperscript{39} Allowing companies in developed countries to appropriate developing countries' IP creates a powerful competitor that will likely put many traditional laborers out of work. Though introducing competition may help to bring costs down for consumers, it could also be devastating for those people whose livelihoods depend on selling traditional cultural items. In addition, handicrafts have been seen as a way to help traditionally oppressed people, such as women, achieve economic independence.\textsuperscript{40}

The economic and humanitarian arguments for the protection of TCMs are closely linked. Consumers are often willing to pay more for a socially beneficial product. As Landes and Posner put it, "The fact that two goods have the same chemical formula does not make them of equal quality to even the most coolly rational consumer."\textsuperscript{41} Though they may be produced using the same materials, consumers may not consider a \textit{kikoi} made in the UK and Kenya to be the same product. Therefore, giving a UK company a monopoly on the term would be detrimental not only to traditional foreign producers in Kenya, but also to domestic consumers in the UK.

\section*{III. Analysis of Current Law}

\subsection*{A. History of International IP Law}

The Paris Convention first established requirements for industrial property rights, such as inventions, trademarks, and industrial designs in the nineteenth century.\textsuperscript{42} A few years later, the Berne Convention introduced the concept of copyright.\textsuperscript{43} It was not until nearly a century later that WIPO was established. Before long, however, a schism emerged in WIPO between developed countries,

\begin{itemize}
  \item \textsuperscript{38}Several countries have as much as one-fifth of their labor force working in crafts and as many as 90 percent of women in developing countries are involved in crafts. Caroline Ramsay Merriam, \textit{Characteristics of World Trade in Crafts}, \textsuperscript{*3} (CHR International), online at http://www.chfhq.org/files/Characteristics%20of%20World%20Trade%20in%20Crafts.pdf (visited Feb 27, 2012).
  \item \textsuperscript{41}Landes and Posner, 30 J L & Econ at 275 (cited in note 21).
  \item \textsuperscript{42}Paris Convention (cited in note 10).
  \item \textsuperscript{43}Berne Convention (cited in note 11).
\end{itemize}
which advocated for stronger IPRs, and developing countries, which wanted weaker ones.\(^{44}\) When the seventh revision of the Paris Convention, which fell under the auspices of WIPO, failed to achieve any results in 1980, developed countries then moved the negotiations to GATT.\(^{45}\) Unlike WIPO negotiations, GATT negotiations allowed developed countries to exchange stronger IPRs for benefits for developing countries in other fields. The negotiations also led to the creation of the World Trade Organization (WTO), which offered effective enforcement of agreements and a dispute resolution mechanism, something WIPO had lacked.\(^{46}\)

Members of GATT negotiated for a more comprehensive IP agreement during the Uruguay Round and adopted TRIPS on April 15, 1994, in Marrakesh.\(^{47}\) While developing countries lost the fight against stronger IPRs as the norm in international law, they insisted on highlighting the importance of policy objectives in TRIPS. Article 7 states that IPRs should be used to further social and economic development:

> The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.\(^{49}\)

Two other important principles were also included in TRIPS: national treatment and most favored nation (MFN) treatment. The national treatment provision\(^{50}\) requires the application of equal treatment under domestic laws to foreign and domestic rights holders. It also works to harmonize national laws related to IP.\(^{51}\)

The MFN provision establishes equal treatment between states party.\(^{52}\)

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\(^{45}\) Id at 5–6.

\(^{46}\) Id at 9.

\(^{47}\) Gervais, *The TRIPS Agreement* at 11, 28 (cited in note 12). The agreement allowed for separate compliance dates for developed and developing countries. Id.


\(^{49}\) TRIPS, Art 7 (cited in note 7).

\(^{50}\) Id at Art 3.1 (stating that each member must afford nationals of other member countries the same treatment as its own nationals subject to exceptions provided in previous agreements).


\(^{52}\) TRIPS, Art 4 (cited in note 7) ("With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other
While individual countries' IP frameworks may differ under TRIPS, the agreement sets a minimum standard for intellectual property rights among member countries. Due to the MFN provision, any agreement between TRIPS member countries that affords higher protection of IPRs to one country must be extended to all other member countries. This Comment focuses on the two sections of TRIPS applicable to kikoi, "Trademarks" and "Geographical Indications."

B. TRIPS

1. Article 15: Trademarks.

TRIPS Article 15 provided the first multilateral definition of a trademark: "[a]ny sign ... capable of distinguishing the goods or services of one undertaking from those of other undertakings." A definition of "undertaking" is not provided but appears to mean the mark of a commercial enterprise. Article 15 therefore gives IPRs to marks that distinguish one producer from other producers. Because kikoi is a mark used by numerous individuals and companies in East Africa, it does not fulfill the requirement. This highlights one of the main problems with TRIPS regarding the IP protection of traditional cultural items—the concept of individual intellectual property rights is primarily a Western notion. IP in developing countries is often a collective effort of numerous individuals or even entire communities. Since the collective nature of traditional knowledge bars the protection of most IP laws, traditional artists are left vulnerable to IP theft.
Consequently, by failing to extend trademark protection to traditional cultural items like the *kikoi*, Article 15 may prevent trademarks from doing what they are purported to—reduce consumers’ search costs. Consumers often seek cultural products that are authentic and created in the nation whose culture they represent. Therefore, allowing a UK company to trademark and sell products under an East African name while preventing East Africans from doing the same in the UK would only serve to increase consumers’ search costs and mislead them into thinking they were buying an authentic product. Domestic laws have begun to limit companies’ abilities to exploit traditional cultural items in this way—laws in New Zealand and the US empower their trademark offices to refuse registration to marks that might offend indigenous communities.

2. Article 22: Geographical Indications.

TRIPS was also the first international agreement to establish an IPR for geographical indications. Geographical indications are a relatively modern type of right that protects marks indicating a particular geographic origin. Famous geographical indications include “Bordeaux” and “Burgundy,” which indicate the origins of the wines to which they refer.

The EU was the first to establish geographical indications rights, citing as reasons for establishing them the protection of cultural goods from dilution, the reduction of confusion for consumers, and the potential income for people in developing countries. In the WTO, there were disagreements over the right level of protection for geographical indications. However, unlike with IPRs generally, these disagreements existed not between developed and developing countries, but rather between the new world and the old world. The US and many new world countries sought to incorporate geographical indications into trademarks or eliminate them altogether while the European Communities

62 Reichman, *Implications* at 18 (cited in note 29) (citing the reduction of search costs, the encouragement of consistent quality over time, and the discouragement of conduct that distorts consumer preferences as roles of trademark law). See also Section I.

63 See Section II.

64 Trade Marks Act 2002, Pub Act 2002 No 49, 17(1)(c) (NZ) (stating that grounds for refusing a trademark include offending “a significant section of the community, including Maori”); 15 USC §1052(a) (allowing for the refusal of a trademark that falsely suggests a connection with particular institutions). See United States Patent and Trademark Office, *Native American Tribal Insignia Database*, online at http://www.uspto.gov/trademarks/law/tribal/index.jsp (visited Apr 18, 2012) (stating that the establishment of a database of Native American insignias was created “as an aid in the examination of applications for trademark registration” under 15 USC §1052(a)).


insisted on not only a separate IPR for geographical indications but also higher protections for wine and spirits. The EC successfully negotiated for strong geographical indications protections and these IPRs have continued to be a cause of disagreement and the subject of continued negotiations.

Geographical indications, unlike trademarks, are a collective right, and are therefore better suited to traditional cultural items than trademarks. All producers of a good located in the place indicated by the geographical indication are free to use it. There are three parts to the definition of a geographical indication under TRIPS: (1) the mark must indicate a geographic location, (2) that geographic location must be contained in one member country, and (3) a quality, reputation, or other characteristic of the good must be attributable to that location.

Geographical indications generally identify a geographic location through an appellation of origin, or the name of a geographic place (for example, Bordeaux wine or Roquefort cheese), but they may be any sign or mark that helps the consumer identify the good as originating in a certain place. Symbols, such as the Eiffel Tower's indication that a good originates in France, or terms that have come to be associated with certain countries, such as feta, are examples of geographical indications that do not refer directly to a geographic location. Since kikoi does not explicitly refer to a particular geographic location,

67 The EC, now known as the EU, comprises all of the EU countries. In the WTO, the EU is a member in its own right. WTO, Member Information: The European Union and the WTO, online at http://www.wto.org/english/thewto_e/countries_e/european_communities_e.htm (visited Mar 31, 2012).

68 A few new world wine-producing nations joined the EC in its goal to protect geographical indications related to wine and spirits. Watal, Intellectual Property Rights in the WTO and Developing Countries at 265 (cited in note 20) (noting that Australia, Canada, Chile, and Argentina were also interested in strong protection for wine geographical indications).

69 Concessions were made to the US in the form of Article 24.4, which made an exclusion for good-faith uses of geographical indications and those that had been used continuously for at least 10 years. TRIPS, Art 24.4 (cited in note 7).


71 TRIPS, Art 22.1 (cited in note 7).


the next question is whether it indicates an East African origin. *Kikoi* is a Swahili word that refers to a skirt traditionally worn by men. While it may indeed help consumers identify the origin of the good as African, it may not indicate East Africa or any particular East African country to most consumers. Thus it is not clear *kikoi* even satisfies the first element of a geographical indication.

Second, Article 22 only protects geographical indications originating in one member country or a region or territory within that country. The term *kikoi*, however, has its origins in East Africa generally, not any one particular East African member country. Since the term has its origins in the Swahili culture rather than in any particular country, giving geographical indication protection to Kenya would deny rights to countries such as Tanzania and Uganda. Two possible solutions exist to this problem. First, each member country could file for a separate geographical indication, so that there would be a Kenyan *kikoi*, a Tanzanian *kikoi*, etc. Another, albeit more complicated, solution would be for East African member countries to form a single WTO bloc akin to the EU. The EU acts as a member of the WTO, but each EU member is also a member in its own right. If East African countries were to follow suit, it would allow East Africa to file for geographical indication protection for cultural items originating in various member countries, but would still allow each individual East African country to file for IPRs independently.

Another issue with *kikoi*, which may be either a bane or a boon for the protection of TCMs generally, is the exclusion of generic terms. Article 24.6 states that TRIPS does not require any member to give protection to another member’s geographical indication if the indication is “identical with the term customary in common language as the common name for such goods or services in the territory of that Member.” That is, what may be protected as a geographical indication in one country might lose protection in another if it is customary or common for the good in that country. Examples include Cheddar cheese, Arabica coffee, and kiwifruit. One reason for refusing protection to generic terms is to prevent a linguistic monopoly. However, granting protection for *kikoi* does not create an unreasonable linguistic barrier to

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74 TRIPS, Art 22.1 (cited in note 7).
76 There appears to be no precedent for this in the WTO. However, this is allowed in the EC, where ouzo from Greece and Cyprus is a protected geographical indication. Council Regulation 110/2008, OJ (L39) 16, 52.
competitors. This is illustrated by the number of other terms available to producers to describe the same product: skirt, sarong, or wrap. Since the term kikoi refers only to the skirt itself and not to a type of skirt or the region where it originated, however, it could still be considered generic. The European Court of Justice provides the following definition of a generic geographical indication:

Therefore, as regards a [protected geographical indication], a name becomes generic only if the direct link between, on the one hand, the geographical origin of the product and, on the other hand, a specific quality of that product, its reputation or another characteristic of the product, attributable to that origin, has disappeared, and that the name does no more than describe a style or type of product.\(^7\)

The question of genericness therefore turns on the third element required by Article 22, that is, whether there is a link between the geographical origin and some attribute, either a quality or characteristic, or the reputation of the good.

Most products that are geographical indications are agricultural in nature and so the relationship between the quality or characteristic of the good and the geographical origin is obvious. This is most evident in the context of wine, where the terroir, or geography and climate, is thought to produce the flavors of the particular wine.\(^8\) With the case of the kikoi, this does not appear to be quite so obvious. The kikoi is made of cotton and is known for its bright colors, characteristics that are not obviously linked to East Africa. However, Article 22 also says that the reputation of the good may be attributable to its geographical origin:\(^9\) "Reputation is the result of years of work in association with a product that has created a mental link between that product and its geographical origin."\(^8\) Is kikoi's reputation linked to its geographical origin? A Google search of "kikoy" turned up websites selling the product in various forms. Many of the websites gave a brief description of the item describing it as African, East African, or Kenyan in origin.\(^8\) This suggests that the reputation of the product may be linked to its geographic origin.

\(^7\) Bavaria NV v Bayerischer Brauerbund eV, Case C-343/07 2009 ECR I-05491 (July 2, 2009).


\(^9\) This differs from the Brussels Draft, in which reputation itself was not a characteristic of the good, but an effect of the good's quality or characteristics. UNCTAD-International Centre for Trade and Sustainable Development ("ICTSD") Project on IPRs and Sustainable Development, Resource Book on TRIPS and Development 287–88 (Cambridge 2005).

\(^8\) Gervais, The TRIPS Agreement at 298 (cited in note 12).

\(^8\) See, for example, The Kikoy Co., online at www.kikoy.com (visited Mar 31, 2012) ("Kikoys are exclusive to the East African coast, in particular Kenya, where we weave them with the finest cotton grown in the region."); Kikoy Kiosk, online at www.kikoykiosk.com (visited Mar 31, 2012) ("Our kikoys come directly from Kenya. . . . Each Kikoy is made from cotton grown in Kenya.");
However, the exclusion of generic terms could actually help *kikoi*. Article 24.6 states that no protection is required in countries where the term is generic. This means that while *kikoi* may remain unprotected in countries such as Kenya, where it has become generic, it would likely stay protected in most developed countries, where the Swahili word is uncommon. In East Africa, therefore, it would receive no protection and remain in the public domain where anyone could produce the items under the mark *kikoi*. Thus this generic exclusion could potentially help the GI protection of certain traditional cultural items by simultaneously keeping the term in the public domain in its countries of origin, while also protecting it in the developed countries where it remains most vulnerable to theft.

Even with geographical indications protection, however, TCMs might be under-protected. Article 22.2 states that member countries must provide legal means to prevent the use of a geographical indication that “misleads the public as to the geographical origin” or “constitutes an act of unfair competition” under the Paris Convention. Article 10*bis* of the Paris Convention precludes indications that are “liable to mislead the public” with respect to the nature, manufacture, characteristics, suitability, or quantity of the goods. These two provisions together appear to prohibit the use of a geographical indication when either the public is misled or when the public is likely to be misled. Therefore, it is possible that even with geographical indications protection, a UK company could sell a product called *kikoi* as long as the true geographic origin was also named (perhaps “*kikoy*-style skirts from Kent”). However, this would still likely dilute the reputation of the *kikoi* by severing the link between the *kikoi* and East Africa or offering a potentially inferior-quality product. As a result, many developing countries have criticized TRIPS for providing weaker protection in Article 22 than in Article 23, which establishes geographical indications for wine and spirits and specifically prohibits the use of accompanied expressions such as “kind,” “type,” or “style.”

Because geographical indications for wine and spirits tend to come from developed countries, and Europe in particular, much of the criticism of this two-tiered protection has come from developing countries.

These countries argue that “Article 22 allows producers from other regions to easily usurp a [geographical indication] and free-ride on its reputation without rendering any possibility to the legitimate producers to stop such actions as long as the true geographic origin is also named.”

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84 Council for TRIPS, Proposal from Bulgaria (cited in note 70).

85 See id. The US and Canada have also been opponents of higher protection for wine and spirits. They have apparently been able to evade implementing this higher protection by declaring some of the geographical indications generic or semi-generic. Watal, Intellectual Property Rights in the WTO and Developing Countries at 268 (cited in note 20).
as the true origin of the product is stated."86 Felix Addor and Alexandra Grazioli have argued that the Article 22 protection is inadequate because it allows producers to misappropriate a geographical indication, thus undermining the economic benefits to legitimate producers and misleading consumers as to the authenticity of the product.87

Finally, there appears to be no rational economic reason for having higher protections for wine and spirits than for other goods. Article 23 was a trade concession made during negotiations.88 Indeed, there exist similar items, such as coffee and beer, which receive no greater protection despite having the same qualities as wine and spirits.89 The higher protection for wine and spirits could easily be extended to cover all goods, which would help stop the dilution of TCMs like kikoi. Since TRIPS, efforts to extend the Article 22 protections to match those in Article 23 have begun and may help efforts to protect TCMs.90

86 Addor and Grazioli, 5 J World Intel Prop at 884 (cited in note 23).
87 Id at 880–81.
88 This is not a point of contention between proponents and opponents of extension:
This differential treatment of geographical indications can only be explained in the light of the negotiations of the Uruguay Round. The relevant TRIPS provisions are the result of trade-offs which were specific to the circumstances prevailing at the time of the Uruguay Round negotiations, in particular during the Brussels Ministerial Conference (1990). This was, to some extent, due to the link at that time between the negotiations on geographical indications and the negotiations on agriculture.

WTO, Council for TRIPS, Communication from Bulgaria, the Czech Republic, Egypt, Iceland, India, Kenya, Liechtenstein, Pakistan, Slovenia, Sri Lanka, Switzerland and Turkey, IP/C/W/204/Rev1 (Oct 2, 2000) (arguing that Article 23 should be extended).

The additional level of protection provided under Article 23 is the result of a negotiating compromise reached in the broader context of the Uruguay Round negotiations. This compromise, sought by several wine-producing countries, particularly the EC, represented a significant concession by a number of Members, among them other wine-producing Members, that did not see the need to create an imbalance in [geographical indication] protection by conferring increased protection on wine and spirit [geographical indications].

WTO, Council for TRIPS, Communication from Argentina, Australia, Canada, Chile, Guatemala, New Zealand, Paraguay and the United States, IP/C/W/289 (June 29, 2001) (arguing against extension).


90 See, for example, WTO, General Council, Preparations for the 1999 Ministerial Conference: Communication from Cuba, Dominican Republic, Egypt, Honduras, India, Indonesia, Nicaragua and Pakistan,
C. Related International IP Laws

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (Madrid Agreement), first enacted in 1891, provided a limited extension to the Paris Convention. Article 1.1 prohibited goods bearing "false or deceptive indication[s]." Apparently, the reference to deceptive indications as separate from false indications was a way to prohibit marks that used a qualifier, such as “California Burgundy,” when the mark might nonetheless mislead consumers. This reflects the protections afforded to wine and spirits in TRIPS, but the Madrid Agreement establishes them for all goods. There are only thirty-five contracting members, with the US and a number of European countries not parties to the agreement.

The Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (Lisbon Agreement), drafted in 1958, established protection for appellations of origin. These included actual geographical names of countries, regions, or localities and protection included the prohibition of imitation even if the true origin of the product was indicated (“kind,” “type,” etc.), like the Madrid Agreement. There are only twenty-seven member parties to the Lisbon Agreement. TRIPS was negotiated in part because of the limited acceptance of the Madrid and Lisbon Agreements.

In addition, a number of agreements to centralize registration systems have been created to make it easier to file for IPRs in foreign countries. For example, the Madrid Protocol created a centralized system where a trademark owner can file one application with his own national or regional trademark office and have it sent to an international registration system. However, it is merely a filing

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WT/GC/W/208 (June 17, 1999) (requesting that the protection of Article 23 be extended to other products).


92 Id at Art 1.1.


96 Id at Art 3.


98 See Resource Book at 321 (cited in note 81).

treaty, which means that each country still has the right to determine whether or not to issue protection for a mark.\textsuperscript{100}

D. Other Multilateral and Bilateral IP Agreements

While TRIPS appears to protect TCMs like \textit{kikoi} inadequately, a growing number of other multinational treaties, particularly among developing countries, have emerged to fill the gap.\textsuperscript{101} The Andean Community, consisting of Bolivia, Colombia, Ecuador, and Peru, has an IP treaty with provisions recognizing both individual trademarks\textsuperscript{102} and collective trademarks.\textsuperscript{103} In order to qualify for a collective trademark, there needs to be "legally established associations" of producers who can distinguish the goods of their members from others.\textsuperscript{104} This is one way in which TCMs can receive trademark protection while including not only multiple producers of the goods, but also producers across national boundaries. While establishing legally recognized associations may be a difficult task in poor countries, especially in rural areas, an IP regime that recognizes collective trademarks would help assure consumers of the authenticity of the products.

In addition, multinational blocs in Africa have set up IP systems that may help protect cultural items from misappropriation. There are two main IP groups on the continent: the African Regional Intellectual Property Organization (ARIPO), which consists of English-speaking African nations, and the Organisation Africaine de la Propriété Intellectuelle (OAPI), consisting of many of the French-speaking nations. ARIPO has a centralized registration system for trademarks where each application is sent to every member nation for substantive review.\textsuperscript{105} Under the Banjul Protocol, each member country has one year to determine whether the application complies with the country's domestic laws.\textsuperscript{106} This system protects cultural items by essentially providing a monitoring system for the trademark applications in other African countries. OAPI also

\begin{thebibliography}{99}
\bibitem{100} Id at Art 3.1.
\bibitem{101} See Pak, Comment, 24 Pac McGeorge Global Bus & Dev L J at 394–95 (cited in note 59).
\bibitem{103} Id at Arts 180–81.
\bibitem{104} Id at Art 181.
\bibitem{106} Banjul Protocol § 6.
\end{thebibliography}
oversees a central register, and its Bangui Agreement has a provision for collective marks.\(^{107}\)

Of course, only developing countries are states party to these agreements. Wealthy countries prefer bilateral negotiations because it allows them to exchange trade concessions for stronger IPRs in other countries. Thus, there has been a shift from multilateral to bilateral negotiations regarding IPRs.\(^{108}\) In fact, a surprising proponent of added protection for TCMs comes from bilateral agreements negotiated by the EU. Not surprisingly, perhaps, these agreements all have to do with wine and spirits. For example, the EU–Chile Agreement on Trade in Wines\(^{109}\) protects traditional expressions related to wine geographical indications. This includes terms such as “Vino dulce natural,” “Eiswein,” and “Tawny” on the EU side and “Reserva o Reservas” and “Noble” on the Chilean side.\(^{110}\) These expressions do not indicate a particular geographic area and thus are not likely covered by TRIPS. Indeed the words “Eiswein” and “Tawny” are likely to fall under the TRIPS generic exclusion as they mean “ice wine” and “yellow-brown,” respectively.

A similar agreement between the EU and South Africa gives protection to certain terms for wine and spirits, including “port” and “sherry,” which the EU claims indicate geographic origins.\(^{111}\) Under the agreement, South Africa has twelve years to phase out the use of the terms in its domestic market. The EU’s motivation for this treaty was likely the fact that the terms, along with “grappa” and “ouzo,” would have been deemed generic by the WTO and would thus have remained unprotected by TRIPS.\(^{112}\)

### E. Domestic Laws Protecting Indigenous Traditional Knowledge

The growing clout of indigenous groups means an increasing number of domestic laws that protect indigenous traditional knowledge. For example, the

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\(^{109}\) See Agreement Establishing an Association Between the European Community and its Members States, of the one part, and the Republic of Chile, of the other part, 2002 OJ (L 352) 3 (Nov 18, 2002) (hereinafter EU–Chile Agreement).


\(^{112}\) Id.
the US Indian Arts and Crafts Act makes it illegal to sell any art or craft "in a manner that falsely suggests it is [American] Indian produced, [or] an Indian product." Penalties include up to $250,000 in fines and up to five years in prison for fraud. Similarly, states in the southwestern US have enacted laws that require sellers of these goods to ensure that they are in fact being produced by indigenous people in the traditional way. Native American arts and crafts garner as much as $800 million in the southwestern US alone.

In New Zealand, the trademark office must refuse to register trademarks that offend indigenous cultures. Section 17.1(c) of the Trade Marks Act states that no trademark may be registered that would "be likely to offend a significant section of the community, including Maori." In the US, the Lanham Act also prohibits disparaging marks, though without a focus on indigenous people.

Panama has a sui generis system of IPRs. The National Crafts Department of the Ministry of Commerce and Industry distributes certification stamps to ensure authenticity of products and the state bans any imports resembling indigenous crafts unless the associated indigenous community gives permission. The Department of Collective Rights and Forms of Folkloric Expression grants collective copyrights to indigenous people and traditional culture cannot be registered for IP protection by any third party in any form. Unlike the approaches taken in the US and New Zealand, this system gives the indigenous people themselves, rather than a judiciary, the power to determine whether a good is permissible. Panama's approach has been dubbed an unnecessarily commercial approach to the protection of indigenous knowledge, but nonetheless serves to protect indigenous knowledge from being misappropriated.

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113 Pub L No. 101-644, 104 Stat 4662 (1990), codified in various sections of Titles 18 and 25.
114 18 USC § 1159.
115 Id.
117 Id.
119 15 USC § 1052(a).
121 Fowler, Preventing Counterfeit Craft Designs at 123–24 (cited in note 61).
122 Id.
123 Id.
IV. SOLUTIONS

A number of solutions have been offered to the problem of protecting traditional knowledge. From the expansion of IPRs to eliminating them altogether, scholars differ widely. This Section discusses solutions that have been proposed and introduces a relatively simple solution that may nonetheless have the desired effect of providing protection for TCMs.

A. Extension of Geographical Indications Protection in TRIPS

Some have called the idea of expanding TRIPS Article 23 beyond wine and spirits bad for developing countries, arguing that it would simply further the administrative burden of enforcing IPRs without necessarily bringing any benefits. Others have argued that the costs associated with extending geographical indications protection are marginal in comparison to the total cost of implementing TRIPS. Those who argue for extension say Article 22 provides insufficient protection to goods that are not wine and spirits. In terms of benefits to consumers, Addor and Grazioli note:

The actual level of protection attributed to GIs for wines and spirits gives consumers confidence in the true origin of a product, which has added-value and specific qualities due to its geographical origin. There is no doubt that consumers would also benefit if the scope of Article 23 is extended to products beyond wine and spirits.

In addition, geographical indications are not so different from other IPRs, such as trademarks and patents, which do not have different levels of protection for different types of products.

The costs of expanding Article 22 to include the rights in Article 23 might actually have an effect of reducing costs. Whereas Article 22 requires proof that a mark is misleading or likely to be misleading as to the geographic origin of the product, Article 23 does not require any showing of confusion. If extended to cover all goods, Article 23 protection would reduce the administrative efforts necessary to determine whether there is any confusion; it would be enough simply to show that a producer outside the geographic location was using the

126 Addor and Grazioli, 5 J World Intel Prop at 887 (cited in note 23).
129 TRIPS, Art 23.1 (cited in note 7) (stating that members shall provide means for interested parties to “prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication . . . even when the true origin of the goods is indicated”).
geographical indication. Therefore, the costs associated with determining a violation might actually be reduced.130

B. Public Domain

Others have argued that TCMs like kikoi belong in the public domain. Indeed, there are serious disadvantages to protecting the term, as it may unnecessarily confuse consumers into thinking the good is substantially different from a wrap or sarong when it is essentially the same product. For those who do not care about the origins of a good, this might misleadingly eliminate potential substitutes.131 The monopoly power of trademarks and geographical indications could in fact increase search costs for consumers.

In addition, the incentive benefits conferred by trademark protection, for example to develop a valuable trademark through consistent quality,132 may not apply to traditional items. Traditional people often create handicrafts as a way of expressing their culture or as one of very few options to make a livelihood, not to access a large global market.133 Free riding on their reputation may not have the same effect as free riding on the reputation of a for-profit enterprise. However, as the public domain enthusiast, James Boyle, points out, economic benefits provide incentives even to the least capitalist people. The rosy periwinkle, a plant that contains properties thought to treat diabetes and other chronic diseases, was eradicated by traditional people in Madagascar to make way for food crops.134 This example has been highlighted as one justification for providing traditional people with the economic benefits of IPRs.135 As East Africa becomes more industrialized, people might be less likely to produce traditional items, a problem that could be exacerbated by the existence of large companies in rich countries who can out-produce and out-sell traditional people.

Another problem of granting IPRs for kikoi relates to the lack of "acquired rights." If kikoi were granted geographical indications protection, emigrants from East Africa could not continue to produce the good using that term in their new countries. Since handicrafts are tied more to the traditions of the people than to the land itself, this would be an unnecessary loss. Those who

130 Addor and Grazioli, 5 J World Intel Prop at 889 (cited in note 23).
133 See, for example, Mitchell, 13 J Entrepreneurship at 170 (cited in note 40) (citing family circumstances and economic independence as some of the motives for female entrepreneurs in Africa).
135 See, for example, Kuruk, 48 Am U L Rev at 772 & n 15(cited in note 18).
leave their home countries may find themselves leaving some of their culture behind.\textsuperscript{136}

Keeping \textit{kikoi} in the public domain at least has the advantage of allowing anyone, that is, any East African producer and any company in other countries, to produce the item under the mark. A UK company could not attempt to prevent East Africans from marketing their traditional item in the UK. The public domain, along with certification or collective marks, could actually accomplish for TCMs much of what trademarks and geographical indications attempt to do. It would provide consumers with accurate information, reduce their search costs, and still allow competitors to access the market.

C. Paying Public Domain

A \textit{domaine public payant}, or paying public domain, is a system that allows people to use traditional knowledge without first gaining permission but requires them to provide remuneration to traditional people.\textsuperscript{137} The payment goes to a fund that is entrusted to an NGO or foundation.\textsuperscript{138} The main problem with this system is that the money would go to a third party and may never reach the hands of the actual traditional producers of the \textit{kikoi},\textsuperscript{139} thus eliminating the potential economic benefits of the IPR.

In a similar scheme, Jerome Reichman and Tracy Lewis compare intellectual property law with tort law and argue that using a liability rule can help create economic incentives in developing countries without granting traditional knowledge full IPRs.\textsuperscript{140} They describe a “take and pay” rule, which would allow people to use traditional knowledge without receiving permission, but would require compensation.

These schemes work like compulsory licenses and afford the benefits of the public domain with many of the economic benefits of a traditional IPR. However, the actual delivery of the money to traditional people would likely make the system costly and difficult to implement.

\textsuperscript{136} TRIPS Article 24.4 grants rights to producers of wine and spirits who have used a particular geographical indication continuously for ten years even though not located in the particular geographic location. Extension of Article 24 to apply to goods other than wine and spirits could therefore help avoid this problem.


\textsuperscript{138} See id.

\textsuperscript{139} See Kuruk, \textit{48 Am U L Rev} at 831 (cited in note 18).

\textsuperscript{140} Jerome H. Reichman and Tracy Lewis, \textit{Using Liability Rules to Stimulate Local Innovation in Developing Countries: Application to Traditional Knowledge}, in Keith E. Maskus and Jerome H. Reichman, eds, \textit{International Public Goods and Transfer of Technology Under a Globalized Intellectual Property Regime} 337, 348 (Cambridge 2005) (arguing that such a rule would promote small-scale innovation with fewer costs than other methods).
D. Generic In Any Language Exception

The aforementioned solutions would involve huge and unlikely shifts from the current framework. The public domain solution in particular seems unlikely to occur given how important IPRs are to developed countries. However, a simpler and more narrow solution existing within the current legal framework may accomplish many of the same objectives: if a mark is found to be used generically in commerce in any language spoken in any states party to the agreement, such a finding would trigger cancellation of the mark.

The current TRIPS generic exclusion in Article 24.6 allows members to refuse to protect geographical indications that have become common or customary in their countries. This may help the protection of *kikoi* in this instance, as it allows the term to be protected abroad where companies in wealthy countries may not be able to use it, but allows the term to remain in the public domain in East Africa, where traditional producers can use it. However, a more favorable system for traditional items may actually be one with a broader generic exclusion. It was the UK Trade Marks Act’s narrow exclusion for generic terms, where only terms that were generic in the “common language” of the UK were excluded, that first made *kikoi* vulnerable to IP theft in the UK.\(^{141}\) Thus, a more robust international IP exclusion, where any term that was generic *in any language* spoken by any people of any states party was excluded from IP protection, may actually help traditional cultural marks. If a trademark or geographical indication turns out to be used generically in commerce in any language, it would be subject to cancellation. Traditional producers who want to distinguish their goods from non-traditional producers could use appellations such as “Made in Kenya” or certification marks to ensure the authenticity of their products.

This is a narrower version of the public domain solution, as the burden of showing genericness would rest with the state party who wants to cancel the right. Since courts frequently analyze genericness of terms, it would be a relatively easy addition to the current legal framework. In addition, it would require no additional laws regarding TCMs or expressions and would protect TCMs from being misappropriated by other countries simply because the term is fanciful in those countries. An international register of generic TCMs, such as the one proposed by Article 23 of TRIPS for wine and spirits,\(^{142}\) would help make this process easier.

A generic exclusion that takes into account all languages spoken in all states party would be consistent with other IPRs in TRIPS. Patents are protected “without discrimination as to the place of invention, the field of technology and

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141 See Section II.
142 TRIPS, Art 23.4 (cited in note 7).
whether products are imported or locally produced.\textsuperscript{143} In addition, it would not lead to linguistic depletion since only those words used generically \textit{in commerce} would be affected. Words that were generic but not used in commerce could still be registered as trademarks or geographical indications in countries where they were not generic.

A broader generic exclusion allows traditional producers to use their own TCMs, reduces the likelihood of dilution of important cultural marks used commercially, and furthers the stated objective of TRIPS: using IPRs “in a manner conducive to social and economic welfare.”\textsuperscript{144}

V. CONCLUSION

The attempted theft of the \textit{kikoi} by a UK company is analogous to the attempt of a Kenyan company to trademark the word “kilt.” Not only would it constitute a misappropriation of a cultural icon, but it would also divert economic benefits from a tradition whose people have built up the reputation of the item over years. This kind of theft has the possibility of confusing consumers, increasing search costs, and reducing the incentives to producers of continuing to produce the product and in a consistently high-quality fashion. The fact that it is aimed at traditional knowledge frequently found in poor countries makes it damaging to developing countries, especially given the economic benefits traditional handicrafts have in the development of emerging economies. Current and past international IP laws have failed to address traditional knowledge and so the misappropriation of traditional knowledge has continued with little obstruction. A growing movement to protect indigenous goods, using both multilateral treaties and domestic laws, has begun to address the problem, though with a limited scope. While a number of solutions have been proposed, many of them are broad and unlikely to be adopted. Fortunately, a narrower and more likely solution may exist in a generic exclusion for marks that are used generically in commerce in any language.

\textsuperscript{143} Id at Art 27.1.

\textsuperscript{144} Id at Art 7.